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IN THE

# Supreme Court of the United States

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No. 608, October Term, 1937.

Pat.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

v.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

## Petition for Writ of Certiorari.

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In The

# Supreme Court of the United States.

No. . October Term, 1937.

**LINCOLN ENGINEERING CO. OF ILLINOIS,**
Defendant-**Petitioner,**

**vs.**

**STEWART-WARNER CORPORATION,**
Plaintiff-**Respondent.**

## PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Lincoln Engineering Co. of Illinois, prays for a writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit, to review

1) the decision of June 29, 1937 of that Court (R pp 628-644 and reported at 91 Fed 2d 757) and

2) the judgment of that Court entered June 29, 1937 (R p 645),

holding plaintiff-respondent's Butler patent No. 1,593,791* (predicated upon a *hose-coupler* im-

*Also litigated in a score of other suits; in all but two of which there was neither a full and adequate defense nor any published opinion. Both of the defended suits were decided against plaintiff-respondent (81 Fed 2d 786; and 15 F. Supp. 410).

provement) valid, and "contributorily" infringed by a *grease-cup,*

and

with respect to which decision and judgment a petition for rehearing was denied on September 15, 1937 (R p 719),

which decision and judgment of said Circuit Court of Appeals in the case at bar are:

1) in direct conflict with the decision of the United States Circuit Court of Appeals for the Eighth Circuit with respect to the same matter, namely, the scope and infringement of the **same patent** as here in suit, in the case of Stewart-Warner v. Jiffy, 81 Fed (2d) 786, (Certiorari denied 299 U. S. 554); and

2) in direct conflict with the decision of the United States District Court for the Western District of Pennsylvania, as to the same matter, namely, the validity of the **same patent** here in suit, in the cases of Stewart-Warner v. Rogers and Stewart-Warner v. Universal Lubricating Systems, Inc. (15 F. Supp. 410), wherein that Court held the Butler patent here in suit **invalid** on the controlling authority of this Court's decision announced by Mr. Justice Roberts in the Rogers v. Alemite case (298 U. S. 415); and

3) in direct conflict with the decision of this Court in said case of Rogers v. Alemite (298 U. S. 415), involving one of plaintiff-respondent's earlier patents of the **same** type as the one here in suit, and presenting **precisely parallel facts** and the

same legal situation as in the case at bar, and involving and deciding precisely the same important question of patent law as involved in the case at bar, this Court's decision in the Rogers v. Alemite case having since been followed by the District Court in the cases of Stewart-Warner v. Rogers and Universal (15 F. Supp. 410), as an authority of this Court, controlling with respect to the Butler patent here in suit.

Respondent has taken appeals to the Court of Appeals for the Third Circuit (Nos. 6350 and 6351) in its Rogers suit and in its Universal suit (15 F. Supp. 410).

Respondent has also filed a Motion in its aforesaid two appeals to the Circuit Court of Appeals for the Third Circuit, asking that Court to postpone and continue the hearing in these two appeals until this Court has passed upon this Petition for writ of certiorari in the case at bar;—asserting (as its reason) the controlling effect of this Court's decision in the case at bar upon respondent's two appeals in the Third Circuit.

A transcript of record of the case at bar, including the proceedings in the said Circuit Court of Appeals for the Seventh Circuit, is furnished herewith in accordance with Rule 38 of the Rules of this Court.

## SUMMARY AND SHORT STATEMENT OF MATTER INVOLVED.

### Plaintiff-Respondent Was Recently Before This Court on the Same Question.

The plaintiff-respondent, Stewart-Warner Corporation, in the case at bar, was recently before this Court in two

other cases presenting precisely parallel facts and the same legal situation as in the case at bar, to wit, the cases of:

Bassick Mfg. Co. v. Hollingshead Co.,
Rogers et al. v. Alemite Corp., } 298 U. S. 415.

The Alemite Corporation, formerly known as the Bassick Mfg. Co., was and is a wholly-owned subsidiary and predecessor in business of the Stewart-Warner Corporation, the latter having earlier conducted the lubricating-equipment branch of its business and held its many patents relating to such business, in the name of its said subsidiary, but more recently in its own name.

**The factual situation is exactly parallel and the legal situation is precisely the same in the case at bar as in the recent case of Rogers v. Alemite (298 U. S. 415) involving respondent's earlier Gullborg patent.**

The Butler patent in suit (just like respondent's earlier Gullborg patent No. 1,307,734 which was adjudicated by this Court at 298 U. S. 415), discloses several separate and distinct mechanical devices, each complete in itself and each having a separate and independent status in the art of lubrication* and constituting separate articles of commerce and manufacture;—said several separate and distinct devices having been customarily used in conjunction with each other.*

The only relationship existing between said several separate and distinct devices is that each device constitutes the generically old environment in which the other devices are customarily used.

(It is much the same as an incandescent electric bulb or lamp is customarily used with an electric socket or vice

*Long prior to Butler's application for the patent in suit.

versa; or much the same as a screw is customarily used with a screw driver, or vice versa; or much the same as a bottle-cap opener is customarily used with a bottle-cap and bottle or vice versa; or much the same as a fire engine is customarily used with a fire hydrant in the street and a hose-coupler in connection therewith; and so on ad infinitum).

The subject-matter of the Butler patent in suit is generally the same as the subject matter of respondent's earlier and much litigated Gullborg patent No. 1,307,734, to wit:

(A) A grease-cup or so-called "fitting" or "nipple" adapted to be secured to the various bearings of an automobile or other machinery;

(B) A separate and generally portable grease pump, compressor or so-called "grease-gun" for pumping grease under suitable pressure, and

(C) A hose-coupler on the end of the discharge hose of the grease pump or compressor or "grease gun", for temporarily making a fluid-conducting connection between the discharge hose of the pump or compressor, on one hand, and the grease cup, fitting or nipple, on the other hand.

Indeed, right up to the time it suffered the adverse decision of this Court on its earlier Gullborg patent (298 U. S. 415)

respondent had firmly relied* upon the many deci-

*Both in the trial court in the case at bar, as well as in the trial court in its companion suits on the same Butler patent (decision is reported at 15 Fed. Sup 410).

sions* of the Courts on its earlier Gullborg patent which this Court thereafter reversed (either directly or in effect) in the cases of Bassick v. Hollingshead and Rogers v. Alemite (298 U. S. 415);

respondent having contended** that its earlier Gullborg patent No. 1,307,734, and the many adjudications thereon favorable to it, presented cases "on all fours" with the situation under its more recent Butler patent here involved.

The situation in the case at bar is in fact "on all fours" with the situation before this Court on claims 1, 2, 3, 4 and 8 of Gullborg patent No. 1,307,734 in Rogers v. Alemite, 298 U. S. 415.

The United States District Court for the Western District of Pennsylvania, in respondent's suits entitled Stewart-Warner v. Rogers and Stewart-Warner v. Universal, held the Butler patent here in suit invalid (15 F. Supp. 410) on the authority of this Court's decision in Rogers v. Alemite (298 U. S. 415).

The trial court in the case at bar failed to follow this Court's decision in Rogers v. Alemite (298 U. S. 415)

notwithstanding respondent's contention before that court that the prior decisions of the courts on its

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*Bassick v. Auto Equipment Co., 13 Fed 2d 463 (CCA 7).
Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6).
Larkin v. Bassick, 19 Fed 2d 944 (CCA 7).
Bassick v. Adams, 52 Fed 2d 36 (CCA 2).
Alemite v. Rogers, 5 F. Supp. 940 (D. C.)
Rogers v. Alemite, 74 Fed 2d 1019 (CCA 3).
} Reversed at 298 U. S. 415.

**Both in the trial court in the case at bar, as well as in the trial court in its companion suits on the same Butler patent (decision is reported at 15 Fed. Sup 410).

earlier Gullborg patent No. 1,307,734** constituted controlling authorities for respondent's position under its more recent Butler patent No. 1,593,791 here in suit

and

notwithstanding that respondent's controlling authorities were reversed by this Court in Rogers v. Alemite (298 U. S. 415), after respondent had so firmly relied upon such authorities in its brief to the trial court.

**The sole distinction relied upon by the trial court**

between

the Butler patent in the case at bar

and

the earlier Gullborg patent in Rogers v. Alemite (298 U. S. 415)

was the supposed "*pioneer*" character of Butler's more recent invention. The District Court said:

"The rather **startling** features of the Supreme Court's opinion is the announcement that the Leeds case, patent to Berliner 534,543, was a pioneer patent." (emphasis supplied.) (15 F. Supp. 577; R. p. 613.)

"The situation is not one where the language of the Supreme Court in the Gullborg case is applicable, for

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**Bassick v. Auto Equipment Co., 13 Fed 2d 463 (CCA 7).
Lyman et al v. Bassick, 18 Fed 2d 29 (CCA 6).
Larkin v. Bassick, 19 Fed 2d 944 (CCA 7).
Bassick v. Adams, 52 Fed 2d 36 (CCA 2).
Alemite v. Rogers, 5 F. Supp. 940 (D. C.)
Rogers v. Alemite, 74 Fed 2d 1019 (CCA 3).
} Reversed at 298 U. S. 415.

> in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer." (15 F. Supp. 579; R. p. 616.)

However, the Court of Appeals in the case at bar deprived Butler of the position of a "pioneer", just as did the Court of Appeals for the Eighth Circuit in the Jiffy case.

Thus, the Court of Appeals for the Eighth Circuit in the Jiffy case said:—

> "Although none of these patents actually anticipates the claim of the Butler patent covering his coupler adapted for lubricating apparatus, they preclude any conclusion that his was a pioneer patent in the art of making automatic chucks." (81 Fed. 2d 792.)

The Court of Appeals for the Seventh Circuit in the case at bar in turn said:—

> "The Bassick opinion, while dealing with another patent, is more persuasive in this case, because **the patent in issue here deals with** some of **the same old elements of a combination as were described in the Gullborg patent,** the validity and infringement of which were the subject matter of the Bassick v. Hollingshead opinion.
>
> "The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.
>
> "While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where **the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling.**" (emphasis supplied.) (91 Fed 2d 761; R. p. 633.)

"In the instant case, it is conceded that the **headed nipple** was **not patented.** More, it is **not** patentable. It will be assumed that it was **old.**" (emphasis supplied.)

(91 Fed 2d 763; R. p. 637.)

"We are **not** convinced that the discovery belongs to the pioneer class. It was an improvement, but **not** an outstanding advance. Whether that improvement was such as to justify the issuance of a patent may well be and is seriously debated." (emphasis supplied.)

(91 Fed 2d 765; R. p. 642.)

Thus, notwithstanding the fact that the Court of Appeals for the Seventh Circuit in the case at bar deprived the trial court's decision of its sole support with respect to the attempted distinction between the Gullborg patent in the Rogers v. Alemite case and the Butler patent in the case at bar;—the Court of Appeals nevertheless erroneously failed to follow the clear and unmistakable and admittedly controlling decision of this Court in the Rogers v. Alemite case.

Likewise, while clearly holding that Butler was **not** a pioneer and while even entertaining serious doubts as to there being **any** patentable invention in Butler's coupler, the Court of Appeals in the case at bar nevertheless gave the coupler part of the Butler claim-language a broader construction than was given to it by the Court of Appeals for the Eighth Circuit, and in so doing reached a decision as to the scope of the Butler patent in conflict with that reached by the Court of Appeals for the Eighth Circuit in the Jiffy case.

## The Prior Art in the Case at Bar.

Not only was the "combination" of grease-cup, pump and coupler old, but it was also old long prior to the Butler patent in suit to provide:—

1) "**headed**" type grease-cups or so-called lubricant-receiving "fittings" or "nipples" affixed to the bearings of an automobile or other machinery,

and

2) a perambulatory lubricant-dispensing pump,

and

3) a multi-jawed "**chuck**" type hose-coupler on the discharge end of the pump hose for making temporary and quick-attachable and quick-detachable connection between

   a) the pump-hose or pump-conduit, on one hand,

   and

   b) the grease-cup or so-called "nipple", on the other hand.

The antiquity of this so-called "*combination*" of (1) headed grease-cup, (2) pump and (3) "chuck"-type coupler, is shown by Seng patent 1,322,357 (R. pp. 542 to 544) which discloses precisely this "combination" of grease-cup, pump and coupler.

Butler's **only** asserted improvement is in the internal construction or mechanism of his particular form of multi-jawed "chuck"-type hose-coupler, as distinguished from the internal constructions or mechanisms of the multi-jawed "chuck" type hose-couplers of the prior art, as for instance, that of the Seng patent above referred to, or as, for instance, that of the Newton patent No. 1,118,876 (R. pp. 502-505).

Likewise, "headed" grease-cups or so-called lubricant-receiving "fittings" or "nipples" were used prior to But-

ler not only with multi-jawed "chuck" type hose-couplers as in the Seng patent (R. pp. 542, 544), but also with other types of head-engaging hose-couplers on the discharge ends of lubricant-dispensing pumps, as for instance that of the Winkley patent No. Re. 14667 (R. pp. 526 and 532) and Dupre patent No. 927,337 (R., pp. 494, 499).

**The Patent Claim in Suit and the Charge of Infringement.**

The present suit was tried on claim 2 of Butler patent No. 1,593,791 (granted July 22, 1926), upon a theory of *contributory* infringement precisely the **same** as that presented to this Court in said recent case of Rogers v. Alemite Corp. (298 U. S. 415), that is, precisely the **same** as the theory of *contributory* infringement of Gullborg claims 1, 2, 3, 4 and 8 presented in said Rogers v. Alemite case (298 U. S. 415).

Thus, Butler (like Gullborg*) allegedly invented a hose coupler. The alleged improvement was in the internal construction or mechanism of the hose coupler. However, instead of just claiming his hose coupler, Butler claimed his hose coupler (with its assertedly improved features specifically defined) in so-called "combination" with the old-style pump and the old-style grease-cup or "nipple" with which prior-art hose couplers had customarily been used.

Respondent charges petitioner with *contributory* infringement of the Butler claim because of petitioner's sale of old-style grease-cups usable with the assertedly Butler-invented hose couplers and the old-style pumps manufactured and sold by plaintiff; the old-style grease-cup or "nipple" and the old-style pump or compressor being also included in the patent claim.

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*Gullborg patent 1,307,734, adjudicated by this Court in Rogers v. Alemite, 298 U. S. 415.

## BUTLER CLAIM 2 IN SUIT.

(Held invalid at 15 F. Supp. 410 on authority of 298 U. S. 415.)

| The claim analyzed: | The claim quoted: |
|---|---|
| | "The *combination* with" |
| An old grease-cup. | "a **headed nipple** for receiving lubricant, **of**" |
| An old pump | "a lubricant **compressor** having". |
| | "a **coupling** member for connecting said compressor and nipple" |
| | "comprising" (*the coupler elements 1 to 5 below*) |
| | 1) "a cylinder" (*parts 31 & 32 in Figure 2 constituting the body or housing of the coupler*). |
| | 2) "a piston (*43 and 45*) movable within the cylinder, and having" |
| | 3) "an aperture (*48*) for the discharge of lubricant thereof" |
| | 4) "an apertured sealing seat (*washer 51*) carried by said piston" "for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple," |
| | 5) "radially movable locking elements (*jaws 40*) **carried by the cylinder** coacting with the nipple and" "**actuated by said piston**" (given its radial nipple-gripping motion by the radially compressive action of the radially resilient spring-fingers 42 carried by the piston 43 & 45). "for **compressively** clutching[1] the elements upon the nipple" "whereby the pressure of the lubricant on said piston[2] will move the piston[2] to forcibly **compress**[1] said means (*jaws 40*) while the lubricant is passing through said connecting parts." |

Butler's allegedly new and improved **hose-coupler of Figure 2 of drawings only.**

The Court of Appeals for the Eighth Circuit held that plaintiff-respondent's commercial "Alemite Hydraulic" coupler is **not** the coupler here defined, and that the coupler here defined was never produced or sold by plaintiff. (81 Fed. (2) 786.)

**A Fundamental Question of Law in the Case at Bar.**

One of the questions of law in the case at bar (just as in the Rogers v. Alemite case, 298 U. S. 415), is whether one who invents a better hose-coupler useful for connecting the old-style grease pump and the old-style grease-cup, can have a monopoly of the old-style grease-cup, by the simple expedient of including in his patent claim the old-style grease-cup, in so-called "combination" with his hose coupler.

**This Court's Previous Decision on Facts Exactly Parallel to, and on Law the Same, as Presented by the Case at Bar.**

This Court in the recent case of Rogers v. Alemite (298 U. S. 415) held that a patentee could **not** thus re-monopolize the old-style grease-cup or so-called "nipple" or "fitting" under the guise of a patent predicated upon a coupler improvement. Respondent's scheme and attempt to so monopolize an old style grease-cup

by including such old style grease-cup in a patent claim in so-called "combination" with the inventor's hose coupler, and

by then charging "contributory" infringement against the old style grease-cups usable with his hose coupler,

was condemned by this Court in said recent Rogers v. Alemite case (298 U. S. 415) and was also condemned by the District Court in the Stewart-Warner v. Rogers and Universal cases (15 F. Supp. 410) involving the **same** Butler patent here in suit, under what that District Court deemed to be the **controlling** effect of this Court's decision in the Rogers v. Alemite case.

**The Arguments Which Respondent Successfully Advanced Below Are the Same As It Unsuccessfully Advanced to This Court in Its Earlier Rogers v. Alemite Case.**

Respondent argued below that the accused grease-cup is not an old grease-cup because it was specially dimensioned to be usable, inter alia, with respondent's commercial hose coupler. Obviously, petitioner's accused grease-cup is still just the old grease-cup, because any "newness" which could be argued from its dimensions is clearly outside the Butler patent in suit, as petitioner's accused grease-cup has neither the dimensions nor the proportions of the grease-cup shown in the patent in suit, nor does the patent claim at bar specify **any** dimensions or proportions for the grease-cup.

Likewise, respondent further argued novelty for the old style grease-cup on the theory that the admittedly old style "headed" grease-cup or so-called "nipple" was never before an element in the "combination" of the Butler claim in suit. Such argument, however, is just respondent's way of saying to the Court that the old style "headed" grease-cup or so-called "nipple" never met a Butler coupler until there was a Butler coupler.

Precisely these **same** two arguments were made by respondent in the Rogers v. Alemite case (298 U. S. 415), where, as here, respondent urged that the accused old style grease-cup or so-called "fitting" had new dimensions to fit respondent's Gullborg coupler, and where, as here, respondent at bar urged that while the grease-cup sought to be monopolized was in and of itself old and unpatented, yet it never was an element in the claimed "combination" with Gullborg's new coupler.

## The Decision (CCA 8) in Stewart-Warner v. Jiffy Lubricator Co.

In the case of Stewart-Warner v. Jiffy (81 Fed 2d, 786; CCA 8) the so-called "*combination*" of claim 1 of the Butler patent (like claim 2 in form and substance) was not asserted against a grease-cup for use with a hose-coupler and pump as was claim 2 in the case at bar, but it was asserted against a hose-coupler for use with a grease-cup and pump.

Jiffy's accused hose-coupler was associated with a pump and had dimensions to fit onto and to be usable with the old "pin-fitting" type grease-cup manufactured and sold by respondent

under respondent's earlier Gullborg patent No 1,307,-733, which claimed its particular form of grease-cup per se, and

under claims 14 & 15 of respondent's earlier Gullborg patent No. 1,307,734, which claimed its particular form of grease-cup device in alleged "combination" with the admittedly old pump, old hose and old coupler of the prior art, and

under claims 1, 2, 3, 4 & 8 of the same earlier Gullborg patent No. 1,307,734, which claimed the grease-cup device *generically* (to include both old and new grease-cups) in alleged "combination" with an assertedly improved hose coupler and an admittedly old hose and old pump of the prior art.

In the case at bar, the charge of *contributory* infringement is levelled at defendant-petitioner's old-style grease-cup or so-called "fitting" or "nipple" because usable with the assertedly Butler-invented hose-couplers *manufactured and sold by plaintiff-respondent.*

In the Jiffy case, the charge of *contributory* infringement was levelled at the assertedly Butler-invented coupler of Jiffy's manufacture **when used with an old Gullborg "pin-fitting" type grease-cup** made and sold by plaintiff-respondent under its now expired Gullborg patents.

Both plaintiff-respondent's *assertedly* Butler-invented coupler, as well as Jiffy's *assertedly* Butler-invented coupler are **different** from the only coupler (of the several couplers) disclosed in the Butler specification and drawings upon which the coupler-defining portion of the claim-language is readable (the coupler of Butler Figure 2).

Respondent urged upon both Courts in the Jiffy case that the coupler part of the Butler claim-language should be given a broad interpretation on the ground that unless given such broad interpretation, the coupler part of the Butler claim-language would **not** even cover respondent's own commercial form of coupler asserted by it to have been made under the Butler patent; respondent urging upon the Courts in the Jiffy case (and both Courts finding) the substantial identity between Jiffy's accused coupler and respondent's commercial coupler known as the "Alemite Hydraulic coupler".

However, both

in order to maintain necessary concordance and harmony between the coupler part of the claim-language and the applicable parts of the specification and drawings of the Butler patent upon which the claim was readable, and so to give some meaning to the otherwise vague and indefinite claim-language

as well as

in order to save the Butler patent from invalidity in the Jiffy suit in view of very similar prior-art hose-couplers,

the trial court as well as the Court of Appeals for the Eighth Circuit (in the Jiffy case) construed the coupler part of the Butler claim-language in the light of Butler's specification and drawings,* and the narrow scope so afforded the coupler part of the claim-language not only exculpated Jiffy's accused hose-coupler, but, in the opinion of the Court of Appeals for the Eighth Circuit, equally well and definitely **excluded from the scope of the Butler patent respondent's own commercial hose-couplers assertedly made under the Butler patent. This is the very same hose-coupler** ("Alemite-Hydraulic") **in conjoint use with which your petitioner's old style grease-cup or "nipple" is here charged contributorily to infringe.**

Indeed, the Court of Appeals for the Eighth Circuit found that respondent's said commercial coupler was **copied** by respondent from Jiffy's coupler which Jiffy had submitted to respondent **prior** to respondent's commercialization of this type of coupler.

The appellate decision in the Jiffy suit, if followed in the case at bar, would therefore of necessity also exculpate your petitioner's herein accused grease-cup upon a further ground of **non**-infringement, because the charge of *contributory* infringement levelled at petitioner's grease-cup at bar, is predicated and is absolutely dependent upon respondent's commercial hose-couplers **being** within the scope of its Butler patent.

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*That is, the only parts of the Butler specification and drawings upon which the Butler claim is readable. The Butler claim is clearly not readable upon anything but Figure 2 of the Butler drawings and the corresponding portions of the specification, to wit, the portions of the specification beginning in line 97 of page 2 of the Butler specification (R. p. 468), down to line 8 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

through said connecting parts."

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1) By the radially compressive action of the radially resilient spring-fingers (42) carried by the piston (43 & 45).
2) The piston (43 & 45 + 42) within the coupler.

(Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

Because of the necessarily limited scope of the coupler part of the Butler claim-language, the defendant Jiffy did not urge the further defect in the Butler claim 1, fatal to its very validity, to wit, the unwarranted inclusion therein of the admittedly old-style grease-cup and the admittedly old-style pump.

If respondent had prevailed in the Jiffy suit, it would there have had not only a monopoly of the Jiffy coupler, but also a second 17-year monopoly of the old "Alemite pin-fitting" of its now expired and widely litigated Gullborg patents (298 U. S. 415); for if respondent had prevailed in the Jiffy case, then under respondent's theory of the case at bar, the manufacture and sale of the old "Alemite pin-fitting" would have constituted *contributory* infringement of its more recent Butler patent here in suit, because such old "Alemite pin-fitting" would be usable with a hose-coupler which would then have been held to respond to the coupler part of the language of Butler claim 1.

While the Jiffy decision was on Butler claim 1 and the decision in the case at bar on Butler claim 2, the coupler parts of the language of these two claims are indistinguishable in substance, as will readily be apparent from the two parallel columns on pages 13 and 14 of the brief in support of this petition, where the coupler parts of the language of both Butler claims 1 and 2 are set out verbatim in two parallel columns.

Indeed, the original bill of complaint in the present suit charged infringement of Butler claim 1, not of Butler claim 2, and did not charge infringement against any grease-cup, but, as in the Jiffy suit, charged infringement against a hose-coupler*. After the decision of the trial

*(See original bill of complaint on R. p. 2 and original bill of particulars on R. p. 11.)

court in the Jiffy case, respondent added Butler claim 2 to the case at bar, and also added petitioner's grease-cup to the case at bar, by an amended bill of particulars (R p 14); and after the decision of the Circuit Court of Appeals for the Eighth Circuit (81 Fed 2d 786) in the same Jiffy case, respondent withdrew from the issues at bar Butler claim 1 † and also withdrew the petitioner's originally accused hose-coupler.

## REASONS RELIED UPON FOR ALLOWING THE WRIT OF CERTIORARI.

The discretionary power of this Court is invoked on the following grounds, in accordance with Rule 38 (5b) of the Rules of this Court:—

1. The Circuit Court of Appeals for the Seventh Circuit has rendered an erroneous decision in the case at bar, in direct conflict with the decision of the United States Court of Appeals for the Eighth Circuit on the same matter, namely, on the scope and infringement of the **same patent** as here in suit. The conflicting decision of the Court of Appeals for the Eighth Circuit is in the case of Stewart-Warner v. Jiffy Lubricator Co., 81 Fed 2d 786 (certiorari denied, 299 U. S. 554).

2. The Circuit Court of Appeals for the Seventh Circuit has rendered an erroneous decision in the case at bar, in direct conflict with the decision of this Court on the same matter, namely, the right of a patentee to monopolize old-style grease-cups, through a patent predicated upon an asserted improvement in a hose-coupler usable with the old-style grease-cup, this Court's aforesaid decision being in the case of Rogers v. Alemite (298 U. S. 415). This

†At the opening of the trial at bar, R. p. 33-35.

Court's decision has been followed by a District Court with respect to the **same patent** here in suit, namely, the District Court for the Western District of Pennsylvania, in two suits, entitled Stewart-Warner vs. Rogers and Stewart-Warner vs. Universal (15 F. Supp. 410), wherein that District Court held the Butler patent here in suit invalid on the authority of this Court's aforesaid decision in Rogers v. Alemite, which that District Court deemed **controlling** with respect to the Butler patent here in suit.

3. The Court of Appeals for the Seventh Circuit has decided an important question of federal law, namely patent law*, in a way which is untenable and in conflict with the weight of authority as expressed in the hereinbelow cited cases, and has decided an important federal question, namely an important point of patent law, in a way which is in conflict with applicable decisions of this Court and other courts:

Heald v. Rice, 104 U. S. 737, 755;
Underwood v. Gerber, 149 U. S. 224, 227;
General Electric v. Ohio Brass, 277 Fed 917 (CCA 3);
Langen v. Warren Axe and Tool Co., 184 Fed 720, 721 (CCA 3);
In re Ratican, 36 App. D. C. 95;
In re Germantown Trust Co., 57 Fed 2d 365 (U. S. Ct. of Customs & Patent Appeals);
Kodell Electric v. Warren Telechron, 62 Fed 2d 692 (CCA 6);

*Patents are non-existent in the common law and in the State statutory law. Patents are solely creations of federal statutory law, pursuant to Article I, Section 8 of the United States Constitution.

Alemite v. Lubrair, 62 Fed 2d 899 (CCA 1);
Rogers v. Alemite
Bassick v. Hollingshead } 298 U. S. 415 ;—

said important question of patent law being whether an inventor of an improvement in one device may claim said improved device in so-called "combination" with admittedly old and unpatentable articles of commerce or expedients of the prior-art in the public domain, in combination with which prior-art articles or expedients, other devices of the class improved by the patentee had always been used;—the weight of authority being that such claim is invalid or not patentable because drawn to an old and exhausted combination of the assertedly improved device and the old articles of commerce or expedients of the prior-art, and that the patentee's invention is limited and therefore his claim of monopoly must be limited entirely to his improved device.

4. The Circuit Court of Appeals for the Seventh Circuit has rendered an erroneous decision in the case at bar on an important question of federal law in direct conflict with Sec. 3 of the Act of Oct. 15, 1914; 33 Stat. L. 731, known as the Clayton Act, and in direct conflict with applicable decisions of this Court on the same matter, and in direct conflict with the applicable decisions of other Circuit Courts of Appeals and in direct conflict with the applicable earlier decision of the same Court (CCA 7) on the same matter. This important question of law, erroneously decided by the Circuit Court of Appeals for the Seventh Circuit in the case at bar, is distinct from the ordinary issues of validity and infringement of a particular patent, and

goes not only to the scope of monopolies contemplated and intended by the patent laws, but also

goes to the expressed prohibition under Section 3 of the Clayton Act of monopolies, and also

goes to the broad and general question of implied license by estoppel flowing from the unconditional and unrestricted sale by the patent owner of the assertedly improved device upon which the patent is predicated.

The matter here involved has been considered, in the applicable decisions, from several different points of view, but all reaching the same result or conclusion, and accordingly the matter here involved may be variously stated as follows:

(a) A patent owner who has manufactured and sold an assertedly improved and patentable device (a hose coupler) shall **not** prohibit or restrict the proper and only possible use of that device (the hose coupler) by reason of his ownership of a patent covering that article (the hose coupler) in so-called "combination" with the ordinary old style and unpatented things or devices (old grease-cups and old pumps) with which it must necessarily be used, and without which his assertedly patentable article (the hose coupler) has no utility at all;

or, otherwise stated

An owner of a patent on a combination of an assertedly improved device with admittedly old style and unpatented devices with which his assertedly improved device must necessarily be used, shall **not** impose, as a condition of the sale of his assertedly improved device, that the same shall **not** be used in conjunction or in so-called "combina-

tion'' with the aforesaid old style devices sold by a competitor;

(b) An owner of a patent, the claims of which include an assertedly improved device in so-called ''combination'' with other old devices or expedients of the prior art or old articles of commerce, who has freely distributed and sold his assertedly improved device of the patent claim without any condition or restriction attaching to the sale thereof, shall be deemed to have given an implied license (under the principle of estoppel) to the purchaser of such improved device, to use that improved device with the aforesaid old devices or expedients of the prior art or old articles of commerce purchased from a source other than the patent owner (notwithstanding the fact that such old devices or expedients of the prior art or old articles of commerce are included in the patent claim in broad and all-inclusive language).

The aforesaid decisions of this Court and of Circuit Courts of Appeals with which the decision of the Court of Appeals for the Seventh Circuit in the case at bar is in conflict on the important question of law and matter hereinabove variously stated, are:

United Shoe Mach. Corp. v. U. S., 258 U. S. 451;
Radio Corp. v. Lord, 28 Fed 2d, 257 (CCA 3), (Certiorari denied 278 U. S. 648);
Edison Electric Light Co. v. Peninsular Light, Power & Heat Co., 101 Fed 831 (CCA 6);
Thompson-Houston Electric Co. v. Illinois Telephone Construction Co., 152 Fed 631 (CCA 7);

Carbice v. American Patents Development Corp., 283 U. S. 27;
International Business Machines Corp. v. U. S., 298 U. S. 131;
Rogers v. Alemite, 298 U. S. 415.
Bassick v. Hollingshead, 298 U. S. 415;
Hollingshead v. Bassick, 73 Fed 2d 543 (CCA 6) (Affirmed by this court at 298 U. S. 415);
Alemite v. Lubrair, 62 Fed 2d 899 (CCA 1).

WHEREFORE your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Seventh Circuit sitting at Chicago, Illinois, commanding said Court to certify and send to this Court, on a date to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, and that the judgment of the Circuit Court of Appeals for the Seventh Circuit may be reversed and that your petitioner may be granted such other and further relief as may seem proper.

LINCOLN ENGINEERING CO. OF ILLINOIS,

By LEONARD L. KALISH,
DELOS G. HAYNES,
LLOYD R. KOENIG,
*Counsel for Petitioner.*

The undersigned hereby certify that the foregoing petition is in their opinion well-founded, and that the case is one in which petitioner's prayer should be granted by this Court.

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